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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application No.: 09/725,788
Filed November 29, 2000
Original Patent No.: 5,842,807
Issued: December 1, 1998
Patentee: Chun Yuen To
For RING BINDER
Examiner Mark T. Henderson

Art Unit 3722

R.Kent
10/7/03# 15/
Request
Record

September 3, 2003

LETTER TO THE PATENT AND TRADEMARK OFFICE

TO THE COMMISSIONER FOR PATENTS,

SIR:

This letter is responsive to the Office action of July 31, 2003 regarding the above-identified patent application.

The Office action rejects the pending claims under 35 U.S.C. §103(a) in view of Cheng, U.S. Patent No. 5,879,097 ("Cheng"). However, Cheng and the present reissue patent application were and continue to be commonly owned. Accordingly, under 35 U.S.C. §103(c), this rejection should be withdrawn.

I. STATEMENT OF THE LAW AND MATERIAL FACTS

Certain prior art is not available to make a rejection under 35 U.S.C. §103(a). More specifically, 35. U.S.C. §103(c) provides:

"Subject matter developed by another person, which qualifies as prior art only under one or more of the following subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

MPEP §706.02(l)(1) interprets the term "commonly owned" to mean:

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". . . that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person(s) or organization(s)."

The Office action cites Cheng as the sole reference to reject the claims under 35 U.S.C. §103(a). The application which resulted in the Cheng patent was filed on April 3, 1996, claiming priority from U.K. application No. 9509380, filed May 9, 1995. The Cheng patent issued on March 9, 1999. The subject matter of the present reissue application (U.S. Patent No. 5,842,807) was filed as application No. 707,398 on September 4, 1996, and claimed priority of U.K. application No. 9517933, filed September 6, 1995. U.S. Patent No. 5,842,807 issued on December 1, 1998.

Because Cheng was not published for more than one year prior to the filing of the present application, it cannot qualify as prior art under 35 U.S.C. §102(b). The only section under which Cheng may qualify as prior art against the present reissue application is under §102(e)(2), i.e., as "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent"

II. STATEMENT OF COMMON OWNERSHIP

According to MPEP §706.02(1)(2)(II), in order to remove a reference as prior art under 35 U.S.C. §103(c) a clear statement that the subject matter was commonly owned at the time the later invention was made must be made. No other evidence is necessary.

(a) Statement of Common Ownership

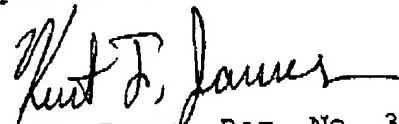
Application Serial No. 707,398 (corresponding to U.S. Patent No. 5,842,807 and the present reissue application) and U.S. Patent No. 5,879,097 (Cheng) were, at the time the invention of application 707,398 was made, owned by World Wide Stationery Manufacturing Company, Ltd.

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III. CONCLUSION

In view of the foregoing, applicant requests that Cheng be withdrawn as a reference and the pending claims 1-30 be allowed. If there are any questions, applicant requests that the undersigned be phoned.

Respectfully submitted,



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Office (in response to Office action dated July 31, 2003)

Applicant's Name: Chun Yuen To

Serial No. (Control No.): 09/725,788 Examiner: M. Henderson

Filing Date: November 29, 2000 Art Unit: 3722

Application Title: RING BINDER

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